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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,810	03/24/2004	Michael Albanese	10555-6	4378

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BRADLEY N. RUBEN, PC  
463 FIRST ST, SUITE 5A  
HOBOKEN, NJ 07030

EXAMINER
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DESAI, ANISH P

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/807,810

Applicant(s)

ALBANESE ET AL.

Examiner

Anish Desai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17, 19-23, 42 and 43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17, 19-23, 42 and 43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The applicant's arguments in response to the Office action dated 03/31/06 have been fully considered.

1. Claims 1-16, 18, and 24-41 are cancelled. Claims 17, 19-23, 42, and 43 are pending.
2. The art rejections of Figliuzzi (US 3,537,578) and Thomason (US 4,195,787) are withdrawn in view of the present amendments and response (see pages 2-3 of 06/01/06 response). Figliuzzi and Thomason do not teach the insulating sheet material formed of a solid color. However, upon further consideration a new ground of rejection is made over Figliuzzi (US 3,537,578), Thomason (US 4,195,787), and Hughey et al. (US 6,596,945 B1).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 17, 19-21, 22, 23, 42, and 43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 17 and 22 recite "an unscored length of electrically insulating sheet material", the limitation of "unscored" is a negative limitation which is not fully supported by the specification of the

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present invention. Note that the specification does not have a written portion that would clearly suggest that the sheet is not scored or not needed to be scored. An example or drawing merely lacking a feature is not sufficient to support the explicit exclusion of that feature. Any claims containing a negative limitation, which does not have basis in the original disclosure, should be rejected under 35 U.S.C 112, first paragraph as failing to comply with the written description requirement. See *Ex Parte Grasselli*, 231 USPQ 393 (bd. App.1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 22 recites "first solid color", it is unclear as to what applicant means by "solid". Does applicant want to convey that the backing (insulating sheet) of the claimed tape is opaque?

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 17,19-23,42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Figliuzzi (US 3,537,578) in view of Thomason (US 4,195,787) and Hughey et al. (US 6,596,945 B1).

Figliuzzi teaches a pressure sensitive adhesive tape such as an insulating tape (Column 1, lines 7-10). Figure 3 of Figliuzzi shows a spiral roll of a tape. The invention of Figliuzzi relates to a new and improved means for marking a tape such that the location of the free end of the tape can be ascertained in order to remove the tape from a roll (Column 1, lines 1-6). The roll of Figliuzzi is not scored (Figures 1, 2, and 4). Additionally, the roll Figure 3 of Figliuzzi shows a spiral roll of a tape with overlying multiple layers and a free end 13 of the tape, which reads on electrically insulating sheet material having a first side and a second side, and releasably adhered to itself in a spiral roll of overlying multiple layers, the layers extending from a first end interior the roll to a second free end overlying the first side of the next adjacent radially inward layer of material as claimed in claim 17. Further the tape of Figliuzzi has an adhesive coated on one side of the tape (claim 1). Moreover, Figliuzzi teaches that the markings 12 on the tape extends diagonally from one corner of the tape at the end thereof down to the other end thereof at the outer corner of the tape (Column 1, lines 44-47), which reads

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on pattern extending substantially continuously from said first end to said second end as claimed in claim 17. Further, Figures 1, 2 and 4 along with the claim 4 of Figliuzzi disclose a printed pattern on the tape, which is substantially continuous. Regarding claim 19, although Figliuzzi does not explicitly teach dashed or dotted lines, however Figliuzzi broadly teaches a pattern in the form of a line (Figure 1) on a tape such that the free end of the tape can be easily identified. Thus, in the absence of unexpected results, a skilled artisan can obviously choose the pattern of dashed or dotted lines on the tape of Figliuzzi, motivated by the desire to easily identify the free end of the tape. With respect to claim 20, Figure 2 and claim 4 of Figliuzzi read on the claimed limitation of the pattern at the edge is discontinuous with the pattern on the juxtaposed surface of the next adjacent radially inward layer. With respect to claim 21, Figures 1, 2, and 4 of Figliuzzi show pattern of a line, a curved line, and a sinusoidal curve. Although Figliuzzi does not explicitly teach the combination of pattern as claimed in claim 21, since the invention of Figliuzzi is in the same problem solving area as the applicant (i.e. to identify the free end of the tape), in absence of any unexpected results, a combination of patterns involves only a routine skill in the art, motivated by the desire to determine the free end of the tape easily.

Figliuzzi is silent as to teaching of at least two line segments each having color different than that of the first side of the sheet material, an indicia pattern comprising at least two lines wherein each line being a color different than the first solid color of the sheet material, at least two lines are same color, said color being selected from the group consisting of green, white and red, and at least two line segments each has a

color different than the other. However, Thomason teaches rolled products (Column 1, lines 25-26) such as tissue paper, friction tape, electrical tape etc. (Column 1, lines 7-10). The invention of Thomason provides marking arrangements, which permits easy access to the beginning or the front part of the rolled product (Column 1, lines 11-13). In Figures 1-7, especially Figures 1-4, Thomason show decorative lines (also called by marking or pattern by Thomason) (Column 1, line 19). Further, Figures 1 and 2 of Thomason seem to show plurality of lines that are side by side or in a spaced apart relationship. Thus, a skilled artisan would have found it obvious to use at least two line segments in the invention of Figliuzzi, motivated by the desire to enhance the aesthetics and to easily locate the free end of the tape of Figliuzzi. Note that Figliuzzi as modified by Thomason is silent as to teaching of line segments each having color different than that of the first side of the sheet material, two lines having same color wherein each color being selected from green, white, and red, and at least two line segments each has a color different than the other. However since Figliuzzi and Thomason are concerned with the same problem as applicant, namely to provide a roll of a tape with a pattern such that the free end of the tape is easily visible to a user. Therefore, it is the examiner's position that the choice of a color involves only routine skill in the art and is not considered to be a patentable feature over the prior art. Therefore, a skilled artisan would have found it obvious to select line segments each having color different than that of the first side of the sheet material, two lines having same color wherein each color being selected from green, white, and red, and at least two line segments each has a

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color different than the other, motivated by desire to easily identify the free end of the tape.

Figliuzzi as modified by Thomason is silent as to teaching of insulating sheet material is formed of a solid color. However, Hughey teaches a novel process or method which produces polymeric tapes such as an insulating tape (Column 7, lines 22-23 and Column 9, line 8). At column 8, lines 51-65, Hughey teaches of adding color dyes in specific quantities to a transparent backing of the tape so that the operator can easily distinguish the edges of the immediate previous layers of the tape from those of the earlier layer. Thus, a skilled artisan would have found it obvious to add dyes in the tape of Figliuzzi and provided solid color to the tape of the Figliuzzi, motivated by the desire to easily identify the free end of the tape from the immediate previous layer of the said tape.

### ***Response to Arguments***

Applicant's arguments filed 06/01/06 have been fully considered but they are not found persuasive.

Applicant argues that in the present invention the lines are spaced apart over substantially entire length of the roll whereas Thomason teaches lines that are spaced apart over only a minimal portion of the length of the roll. The examiner respectfully disagrees. The examiner is not relying on Thomason to show that the lines are spaced apart over the entire length of the roll but rather on Figliuzzi to show that the line is continuous over the entire length of the roll of Figliuzzi's tape. The examiner notes that Figliuzzi teaches the markings 12 on the tape extends diagonally from one corner of the



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tape at the end thereof down to the other end thereof at the outer corner of the tape (Column 1, lines 44-47). Thomason is relied upon only to show that one can have more than one line (markings) on a tape, which is to be used to identify free end of the tape. Additionally, the applicant's arguments that the disclosure of Figliuzzi regarding the marking 12 imprinted on the tape extends diagonally from one corner of the tape at the end thereof down to the other end thereof at the corner of the tape is unworkable for a typical roll of tape e.g. 30 yds are not found persuasive in determination of patentability because they are not commensurate in scope with the claims. Nothing in the claims teaches or suggests anything about the roll of a tape having length of 30 yds.

Applicant argues that the disclosure of Thomason teaches away from the claimed invention because Thomason discloses a score line in the roll. The examiner respectfully disagrees. The examiner is not relying on the teaching of a score in the roll of Thomason because Figliuzzi already discloses unscored tape. The applicant argues that Thomason does not address the problem of unwrapping electrical tape from a spliced line. This argument is found not persuasive in determination of patentability because said argument is not commensurate in scope with the claims. Nothing in the claims teaches or suggests about unwrapping electrical tape from a spliced line.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

APD

*Hai Vo*

**HAI VO  
PRIMARY EXAMINER**